

Attorney's Docket No.: 004701.P001

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: ) Examiner: unknown  
Chee-Seng Chow et al. ) Art Unit: unknown  
Application No.: 09/518,583 )  
Filed: March 3, 2000 )  
For: SYSTEM AND METHOD FOR )  
ACCESSIONG A REMOTE SERVER )  
FROM AN INTRANET WITH A )  
SINGLE SIGN-ON )



RECEIVED  
AUG 17 2000  
OFFICE OF PETITIONS

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

PETITION UNDER 35 U.S.C. § 116 AND 37 C.F.R. § 1.47(a)

Sir:

The present application names four joint inventors, Chee-Seng Chow, James Sung, Jerome Tsung-Yao Chen, and Fiyaz Sundarji. Of these four joint inventors, one, Chee-Seng Chow, has refused to join in the application or cannot be found or reached after diligent effort. Therefore, the remaining three joint inventors petition to make the application on behalf of themselves and the nonsigning inventor under the provisions of 35 U.S.C. § 116 and 37 C.F.R. § 1.47(a).

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### STATEMENT OF FACTS

- 1) Three of the named joint inventors, James Sung, Jerome Tsung-Yao Chen, and Fiyaz Sundarji, have assigned their rights in the present application to GetThere Inc., in an Assignment executed August 10 and August 11, 2000. (ref. Exhibit B in the Appendix.)
- 2) The remaining joint inventor, Chee-Seng Chow, made a general assignment of patent application rights, and made a contractual obligation to make formal assignment of patent application rights in each Invention Idea, in an Employment Agreement executed March 2, 1998. The Employment Agreement was between Chee-Seng Chow and Internet Travel Network, a predecessor in interest and the former corporate entity of GetThere.com, Inc., which in turn is the predecessor in interest and the former corporate entity of the present GetThere Inc., a Delaware corporation.
- 3) Because of the assignments of the present application described in paragraphs 1) and 2) above, GetThere Inc. believes it to be the sole assignee and owner of the present application. For this reason, GetThere Inc., may be referred to as the Assignee hereinafter.
- 4) Chee-Seng Chow was employed by Internet Travel Network and by its successor corporation GetThere.com, Inc., from approximately March 2, 1998 through early September 1999. Mr.

Chow informally goes by an alias of "Sam Chow". At the time of his separation from employment with the Assignee, his mailing address was known to be 6268 Empress Court, San Jose, CA 95129.

- 5) The undersigned patent attorney made repeated attempts to contact Chee-Seng Chow via email starting in early March 2000. Mr. Chow sent the undersigned an email, dated March 14, 2000, in which Mr. Chow stated several reasons why "I'm avoiding direct contact" with GetThere.com, Inc. One specific reason was that Mr. Chow wished to avoid any exposure to "new ideas developed by GetThere after my employment ended". Mr. Chow requested the undersigned's telephone numbers so that he could call and discuss the subject patent application. We immediately sent Mr. Chow the telephone number at which he could contact us. Mr. Chow never called us.
- 6) After these initial emails in March, 2000, Mr. Chow never returned email messages. The undersigned sent two more formal requests, on April 26, 2000, and on May 22, 2000, requesting that Mr. Chow contact us by any means convenient to him in order to discuss his participation in the present application. The undersigned has never again heard from Mr. Chow.
- 7) MPEP 409.2(d) states that

[b]efore a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor.

- 8) On June 15, 2000, a copy of the present patent application papers, including the specification, claims, drawings, a declaration, and an assignment document, was sent to Chee-Seng "Sam" Chow at the address given in paragraph 4 above. These documents were sent via U.S. Certified Mail under serial number Z135214921. This Certified mailing was returned to the undersigned, stamped "Returned to Sender – Unclaimed". (ref. Exhibit C in the Appendix.) The undersigned submits that this offer of proof constitutes the *bona fide* attempt required in MPEP 409.03(d).

- 9) MPEP 409.03(d) further states

[w]hen it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

10) The undersigned submits that the conduct described above of Chee-Seng Chow constitutes a refusal. Supporting evidence is submitted in an Appendix to this Petition. Reasons given for a refusal were given by Mr. Chow in his email of March 14, 2000, quoted above in paragraph 5.

11) MPEP 409.03(a)(A) states

[a]n oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

12) The declaration signed by the three signing joint inventors has the signature block of Chee-Seng Chow left blank. (ref. Exhibit A in the Appendix.) Therefore the undersigned submits that the requirement of MPEP 409.03(a)(A) is satisfied and that the application has been made on behalf of the signing inventors and the nonsigning inventor.

13) MPEP 409.03(a)(B) states

[t]he application must be accompanied by proof that the nonsigning inventor . . . (2) refuses to execute the application papers.

14) The undersigned submits that such proof exists in the statements of this Petition and in the documents of the Appendix.

15) MPEP 409.03(a)(C) states

[t]he last known address of the nonsigning joint inventor must be stated.

- 16) The last known address of Chee-Seng Chow is given above in paragraph 4.
- 17) A check drawn in the amount of \$130.00 is enclosed in accordance with 37 C.F.R. § 1.17(i).

**SUMMARY**

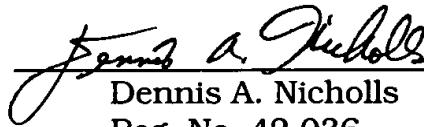
For the foregoing reasons, the undersigned respectfully submits that the requirements of 35 U.S.C. § 116, 37 C.F.R. § 1.47(a), and MPEP 409.03 have been satisfied, and petitions the Commissioner that the present invention be accepted as filed on behalf of the signing inventors and the nonsigning inventor.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would expedite the prosecution of this application, please contact Dennis A. Nicholls at (408) 720-8300.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 11 August, 2000

  
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Dennis A. Nicholls  
Reg. No. 42,036

12400 Wilshire Blvd., Seventh Floor  
Los Angeles, CA 90025 (408) 720-8300

FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on

8-11-2000

Date of Deposit

Tina Domingo

Name of Person Mailing Correspondence

Tina Domingo

8-11-2000

Signature

Date

APPENDIX

Exhibit A – Declaration signed by three joint inventors

Exhibit B – Assignment signed by three joint inventors

Exhibit C – Certified Mail envelope showing “Unclaimed” stamp